REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 5, 6, 8, 9, 11, 15-18, 21-28 and 30-32 are pending, with claims 1, 6, 9, 11, 18, 23-28 and 31 amended by the present amendment. Claims 1, 6, 11, 18, 27 and 31 are independent.

In the Official Action, claims 1, 6, 9, 11, 15, 18, 23-28 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lamkin (U.S. Patent Pub. No. 2005/0251749) in view of Saukkonen (U.S. Patent No. 6,011,590); claims 5, 16, 22, 30 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lamkin in view of Saukkonen and Horowitz (U.S. Patent No. 7,136,394); claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lamkin in view of Saukkonen and Kleiman (U.S. Patent No. 7,200,715); claims 17 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lamkin in view of Saukkonen, Horowitz and Duso (U.S. Patent No. 6,625,750).

Claims 1, 6, 9, 11, 18, 23-28 and 31 are amended to more clearly describe and distinctly claim Applicant's invention. Support for this amendment is found in Applicant's originally filed specification. No new matter is added.

Briefly recapitulating, amended claim 1 is directed to:

> A method for reproducing contents information from an interactive device, comprising:
>
> a) receiving contents information from a contents provider server via an Internet, storing the received contents information in a buffer memory, and synchronously reproducing data read from a storage medium and the stored contents information;

b) if receipt of the contents information from the contents provider server is suspended or delayed, sending a last download position of the contents information in the buffer memory and a request command to the contents provider server to receive contents information subsequent to the last download position while maintaining a playback mode; and

c) receiving the contents information subsequent to the last download position from the contents provider server in response to the request command, and synchronously reproducing the contents information subsequent to the last download position with the data read from the storage medium,

wherein capacity information associated with a storage capacity of the buffer memory is sent to the contents provider server from the interactive device and the contents information is received from the contents provider server variably with respect to a bit rate in response to the capacity information.

As a first point of order, Applicant submits that Lamkin is an improper reference upon which to base a rejection. A comparison of Applicant's originally filed claims and Lamkin's claims reveal that Lamkin copied Applicant's claims verbatim.

Furthermore, the rejections based on Lamkin only cite to Applicant's claims. This situation was discussed during the telephone discussion between the Examiner's supervisor and Applicant's representative on April 21, 2010. During the discussion, the Examiner's supervisor agreed that the current rejections in view of the claims of Lamkin are improper in view of In re Benno, 226 USPQ 683, 786 F.2d 1340. However, the current rejection again fails to comply with the teachings of In re Benno. Applicant again directs the Examiner to In re Benno, 226 USPQ 683, 786 F.2d 1340, which notes, *inter alia*:

> The scope of a patent's claims determines what infringes the patent; it is no measure of what it discloses. A patent discloses only that which it describes, whether specifically or in general terms, so as to convey intelligence to one capable of understanding....Danti's claim 1 does not disclose any structure additional to what the Danti specification discloses. For the above reasons, we hold that the board erred in relying on Danti's claim 1 in deciding that appellant's claims would have been obvious from that reference alone and also in reaching that conclusion.

In other words, it is improper to base a rejection solely on the contents of a patent's claims. The rejection must be based on the disclosure of the specification, not merely the claims. In rejecting Applicant's claims, the Official Action exclusively cites to Lamkin's claims, with one exception. Applicant submits that none of Applicant's features are disclosed in the body of Lamkin. If the Lamkin reference is again applied as a basis of rejection, Applicant requests citations to Lamkin's specification, not claims, for each and every feature recited in Applicant's claims.

Lamkin describes methods and devices for presentation of locally stored media content combined with remote interactively-obtained network media content. Cited paragraph [0796] of Lamkin describes that bookmarks are assigned a number internally when set. A GotoBookmark returns to the same position on the disc as when the bookmark was set (saved). When a bookmark is saved, the saved bookmark will overwrite any existing bookmark for this disc, should one exist. If all of the bookmarks in memory are used, the saved bookmark will overwrite the oldest bookmark. Because navigating to other HTML pages with embedded video can interrupt playback such that other bookmarks can be saved, care should be taken to resume playback using the desired bookmark. If the bookmark number is not known by the JavaScript, passing a parameter of 0 will use the last bookmark that was saved for this disc.

However, in the cited paragraph [0796] of Lamkin, the bookmarks are set or saved by a user for later recall so that playback can be resumed using a desired bookmark. That is, a bookmark is always generated as needed regardless of whether or not the device or method is or is not in a normal operation. In contrast, in Applicant's claimed invention, the last downloaded position of the contents information in the buffer memory is detected and generated during an abnormal operation such as suspension or delay of receipt of the contents information. That is, cited paragraph [0796] does not describe "*if receipt of the contents information from the contents*

provider server is suspended or delayed, sending a last download position of the contents information in the buffer memory and a request command to the contents provider server to receive contents information subsequent to the last download position while maintaining a playback mode."

Because Applicant's claims were copied by Lamkin, the specification of Lamkin also does not disclose or suggest any of Applicant's other claimed features;

Furthermore, as acknowledged by the Official Action, Lamkin does not disclose or suggest Applicant's feature of "capacity information associated with a storage capacity of the buffer memory is sent to the contents provider server from the interactive device and the contents information is received from the contents provider server variably with respect to a bit rate in response to the capacity information." To cure this deficiency, the Official Action applies Saukkonen.

Saukkonen describes a method of transmitting compressed data blocks from a server to a receiver, wherein the compressed data blocks represent an uncompressed data stream, and each block is compressed in relation to a segment of data stream it represents by a compression ratio. The method includes: (a) determining a buffer capacity of a transmission channel between the server and the receiver; (b) transmitting an initial sequence of the compressed data blocks substantially equal to the buffer capacity of the transmission channel; and (c) transmitting subsequent compressed data blocks following the initial sequence after delaying for an amount of time proportional to the compression ratio of each compressed block.

However, like Lamkin, Saukkonen does not disclose or suggest "*if receipt of the contents information from the contents provider server is suspended or delayed, sending a last download position of the contents information in the buffer memory and a request command to the contents*

provider server to receive contents information subsequent to the last download position while maintaining a playback mode."

Applicant submits that independent claims 6, 11, 18, 27 and 31 patentably define over Lamkin and Saukkonen for reasons similar to those presented above relative to amended independent claim 1.

Applicant has considered Kleiman, Horowitz and Duso and submits Kleiman, Horowitz and Duso do not cure the deficiencies of Lamkin and Saukkonen. As none of the cited art, individually or in combination, disclose or suggest at least the above-noted features of independent claims 1, 6, 11, 18, 27 and 31, Applicant submits the inventions defined by claims 1, 6, 11, 18, 27 and 31, and all claims depending therefrom, are not rendered obvious by the asserted references for at least the reasons stated above.

MPEP 2141 notes that prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. MPEP 2141 further notes that the prior art reference (or references when combined) need not teach or suggest all the claim limitations. However, an obviousness-type rejection must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. MPEP 2141 goes on to list exemplary rationales that may support a conclusion of obviousness. However, Applicant submits that the Official Action and the applied references present no objective evidence that would support an obviousness-type rejection of Applicant's amended claims based on one of these exemplary rationales.

CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael E. Monaco, Reg. No. 52,041, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§ 1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

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